

PATENT APPLN. NO. 10/516,621  
RESPONSE UNDER 37 C.F.R. § 1.116

OCT 25 2006

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REMARKS

Claims 1-5 are again rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ashihara et al. (U.S. Patent No. 6,277,912) (hereinafter: "Ashihara") for the reasons set forth in paragraph 4 of the office action of December 21, 2005. This rejection is now moot in view of the cancellation of claims 1 to 5.

Claims 6-11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ashihara. The reasons for rejection are stated in the Action to be "the reasons adequately set forth from paragraph 5 of the office action of December 21, 2005". (Action, page 4, lines 5-6).

(I) The Office is not relying on Verardi et al.

Initially, it is noted that the rejection identifies only "Ashihara et al. (US Patent 6,277,912)" as the basis for the rejection. On the other hand, the reasons for rejection set forth in paragraph 4 of the office action of December 21, 2005, identify the "prior art to Verardi et al.". (Action of December 21, 2005, page 6, line 2 from the bottom of the page). In the response filed May 22, 2006, to the office action of December 21, 2005, applicants assumed that "Verardi et al." was the Verardi et al. reference, U.S. Patent No. 5,863,646 (hereinafter: "Verardi"), cited in the

first action dated August 9, 2005, and that the 35 U.S.C. § 103(a) rejection in paragraph 4 of the office action of December 21, 2005, was based on Ashihara in view of Verardi. Applicants argued that the Office had failed to properly show that Verardi teaches that an aromatic solvent and an ethereal solvent are functionally equivalent in a process for preparing an aqueous resin dispersion composition as disclosed in Ashihara.

The response filed May 22, 2006, forms part of the submission under 37 C.F.R. § 1.114 in the RCE filed June 21, 2006. Additionally, "Comments re Advisory Action Dated June 5, 2006" were included in the submission under 37 C.F.R. § 1.114 in the RCE. In these comments applicants noted (referring to the remarks in the response filed May 22, 2006):

"Applicants also explained that the Office had failed to properly show that Verardi teaches that an aromatic solvent and an ethereal solvent are functionally equivalent in a process for preparing an aqueous resin dispersion composition as disclosed in Ashihara. The description of Verardi cited by the Office, i.e., Col. 6, lines 42-58, describes only that both aromatic solvents and ethereal solvents can be used as a solvent for a solvent-based coating composition. Verardi does not disclose an equivalence of aromatic solvents and an ethereal solvents in a process for preparing an aqueous-based composition as disclosed in Ashihara."

In the present Action, the Office has not responded to the arguments regarding the failure of Verardi to support an equivalence between aromatic solvents and ethereal solvents in a

process for preparing an aqueous-based composition as disclosed in Ashihara. In view of the lack of a response to applicants' arguments and in view of the fact that Verardi is not identified in the rejection, Verardi can not serve as a reference under 35 U.S.C. § 103(a).

It is noted that in the event that the Office maintains the 35 U.S.C. § 103(a) rejection of claims 1-6 based on an alleged functional equivalence between aromatic solvents and ethereal solvents supported by Verardi, a non-final action will be required because any subsequent rejection citing Verardi will amount to a new ground of rejection.

**(II) Ashihara does not support anticipation of claims 1-6 under 35 U.S.C. § 102**

As noted in the response filed May 22, 2006, the Office acknowledges in the action of December 21, 2005, that the process step sequences of Ashihara and of the process recited in claims 6-11 of the present invention are different. Therefore, Ashihara does not disclose each and every element, or limitation, of the process of claims 6-11 and cannot support a case of anticipation of these claims under 35 U.S.C. § 102.

The Office also acknowledges in the office action of December 21, 2005, that "the organic solvent used by Ashihara et al. is an aromatic solvent, not the ethereal solvent as required by the

present application." (Action of December 21, 2005, page 6, lines 3-5 from the bottom of the page). For this reason also Ashihara cannot support a case of anticipation of claims 1-6 under 35 U.S.C. § 102.

Removal of the 35 U.S.C. § 102 rejection of claims 6-11 as being anticipated by Ashihara is in order.

(III) Ashihara does not support a case of prima facie obviousness under 35 U.S.C. § 103(a)

Ashihara is not sufficient to support the rejection of claims 6-11 under 35 U.S.C. § 103(a) because Ashihara does not disclose or suggest the use of an ethereal solvent in the process disclosed therein. The Office has not otherwise shown that a person of ordinary skill in the art would reasonably expect an ethereal solvent to function in the same manner as an aromatic solvent in a process for preparing an aqueous-based composition as disclosed in Ashihara.

(IV) The comparative data in the declaration under 37 C.F.R. § 1.132 filed with the response of May 22, 2006, compare the CLOSEST PRIOR ART and are entitled to full weight

In the office action of December 21, 2005, the Office, while acknowledging that the process step sequences of Ashihara and of the process recited in claims 6-11 of the present invention are different, i.e., whereas Ashihara neutralizes the dispersion after water is added, in the process recited in claims 6-11 the acid-

modified chlorinated polyolefin is neutralized prior to the addition of water as a dispersion medium, stated that "since applicant has not demonstrated the criticality of the process sequence, the selection of any order of performing process step is *prima facie* obvious in the absence of new or unexpected results" (page 6, third paragraph, of the Action).

In response to the position of the Office, applicants submitted a Declaration (under 37 C.F.R. § 1.132) of Tatsuo TSUNEKA which shows the criticality of the process sequence recited in claims 6-11. Comparative Experiments 1 and 2 in the Declaration show that when water is added to a solution of an acid-modified chlorinated polyolefin in an ethereal solvent before neutralization, it is impossible to obtain a dispersion (aqueous resin dispersion composition). In contrast, a dispersion (aqueous resin dispersion composition) can be obtained when water is added to a neutralized solution of an acid-modified chlorinated polyolefin in an ethereal solvent, as is shown in Examples 1 and 2 in the specification of the present application.

In the present Action the Office has taken the position that the comparative data in the declaration filed May 22, 2006, are not sufficient to overcome the rejection of claims 6-11 because the data do not include the chlorinated polyolefins of Ashihara.

Applicants respectfully submit that the position of the Office is not proper and that the data of the declaration are entitled to full weight and consideration. Applicants are required to make a comparison only with the closest prior art. (See MPEP 716.02(e)). The process of Example 6 of Ashihara is not the closest prior art because the example does not use an ethereal solvent. The comparative examples in the declaration use an ethereal solvent and an acid-modified chlorinated polyolefin within the scope of the claims of the application. Only the sequence of steps differs from that of the process recited in claims 6-11 of the application. Therefore, the comparative experiments represent the closest possible prior art. The comparative data are proper and demonstrate the criticality of the claimed process sequence and rebut the Office's case of obviousness.

Removal of the 35 U.S.C. 102 and 35 U.S.C. 103 rejections of the claims is in order and is respectfully requested.

The foregoing is believed to be a complete and proper response to the Office Action dated July 25, 2006, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

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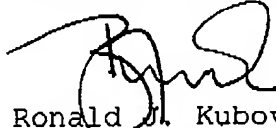
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In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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